

ATTORNEY DOCKET NO
1406-CV (P275US)

PATENT
U.S. 10/706,014

Remarks/ Arguments

In response to the Office Action mailed January 27, 2009, Applicants respectfully request that the Examiner reconsider the rejections of the claims.

Claims 7 – 10, 12 – 15, and 17 – 20 remain.

Claims 17 is being amended.

Claim 17 is objected to as being dependant on cancelled Claim 16. Applicants have amended Claim 17 to overcome this objection.

Claims 7 – 10, 12 – 15, and 17 – 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kikuchi et al.* (U.S. Patent No. 6,553,180), (hereinafter "Kikuchi"). Applicants respectfully traverse these rejections.

Kikuchi does not teach or suggest systems and methods in which a background image for a customized digital versatile disk is generated from one of a plurality of sources, *including the digital versatile disk itself*. Instead, as specifically discussed at Col. 60, Lines 37 - 50 of *Kikuchi*, the background image is selected from a set of N-number of background images pre-stored in a read-only memory (ROM) embedded within MPU 30. Not only is this set of background images limited in number, but it is also controlled by the manufacturer who burned the ROM. In other words, while the user of the *Kikuchi* system can choose from a limited number of background pictures burned in ROM by the manufacturer, the user is clearly not provided with the option of generating a menu background using frames extracted from the corresponding digital versatile disk.

Applicant notes that the excerpt cited by the Examiner at Col. 36, Lines 57 – 64 discusses the compression schemes used for the thumbnails and does not specifically discuss the input format of the menu background pictures stored in the ROM, discussed later at Col. 60, Lines 37 – 50.

Applicant also respectfully notes that taking Official Notice without documentary evidence is only permissible in some limited circumstances. Specifically, the subject

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matter to be inferred by Official Notice must "be capable of instant and unquestionable demonstration." *Manual of Patent Examining Procedure*, § 2144.03. In this case, Applicant submits that the feature of selecting a background image for a customized digital versatile disk from one of a plurality of sources, including the digital versatile disk itself, is not capable of such instant and questionable demonstration. As discussed above, *Kikuchi* only discloses an inflexible system which relies on a limited number of background choices made available by the system manufacturer. No other references have been cited by the Examiner that teach or suggest the feature of providing the user the choice of taking a picture off of the digital versatile disk for generating the menu background. To attempt to "fill-in-the-blank" on such a key technical feature goes beyond the limited scope of taking Official Notice.

However, if the Examiner believes that the feature of selecting a background image for a customized menu, particularly one taken from a digital versatile disk to be navigated, is within the common knowledge of those skilled in the art, Applicant respectfully requests supporting evidence in accordance with MPEP § 2144.03.

Given *Kikuchi* does not teach or suggest systems and methods in which a background image for a customized digital versatile disk is generated from one of a plurality of sources, including the digital versatile disk itself, Applicant respectfully requests that the rejections of Claims 7 – 10, 12 – 15, and 17 – 20 be withdrawn.

No new matter has been added; the claims have been merely amended to more particularly claim the subject matter Applicants believe is inventive. Applicants respectfully submit that the Claims as they now stand are patentably distinct over the art cited during the prosecution thereof.

Applicants respectfully requests a First Month Extension of Time to File this Response. Enclosed with this response is Form PTO/SB/22 with Extension Fees in the amount of \$130.00.

With the addition of no new claims, no additional filing fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account Number 20-0821 of Thompson & Knight LLP.

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If the Examiner has any questions or comments concerning this paper or the present application in general, the Examiner is invited to call the undersigned at (214) 969 - 1749.

Respectfully submitted,

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Date: May 22, 2009

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